

REMARKS

Reconsideration of the above-identified patent application in view of the present amendment and the following remarks is respectfully requested.

The Drawings have been objected to. A Replacement Sheet of Drawings has been attached to this Amendment.

The Specification has been objected to. The Specification has been amended to overcome this objection.

Claims 27 and 28 have been rejected as containing new matter. Claim 27 has been amended to overcome this rejection.

Claims 11 and 26-28 have been rejected as unpatentable over Graham et al., US 2,424,455 in view of Pazdirek et al., US 5,609,433. Claims 13, 14, 16-18, and 22-25 have been indicated as containing allowable subject matter.

Unamended claims 11 and 27 each recite a plastic joint housing (2). Graham et al. disclose a metal housing (10) having crimped-over portions (10f) that secure that joint together (Cols. 3-4, lines 73-75 & 1-4). Pazdirek et al. disclose a ball joint with a plastic housing (10).

The M.P.E.P. sets forth the following criteria for an obviousness rejection under 35 U.S.C. §103:

To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed

combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure.

See, MPEP §706.02(j) citing *In re Vaeck*, 947 F.3d 488, 20 USPQ.2d 1438 (Fed. Cir. 1991)..

If a proposed modification would render a prior art invention unsatisfactory for its intended purpose, there is no suggestion or motivation to make the proposed modification. MPEP §2143.01. It is respectfully submitted that one of ordinary skill in the art would not be motivated to replace the metal housing of *Graham et al.* with the plastic housing of *Pazdirek et al.* Plastic does not have the strength or ductility of metal, and therefore could not be crimped to secured the joint of *Graham et al.* together. Therefore, the joint of *Graham et al.* could not be assembled and secured, as disclosed in *Graham et al.*, if the housing was plastic. Since the modified joint of *Graham et al.* cannot be assembled and secured, the joint of *Graham et al.* has been rendered unsatisfactory for its intended purpose..

Further, for an obviousness rejection under 35 U.S.C. §103, the prior art must be analyzed at the time the invention was made. The use of the teachings of the present invention to find obviousness is impermissible.

Obviousness must not be read into an invention on the basis of applicant's own statements; that is, the prior art must be viewed without reading into that art the applicant's teachings. The issue, then, is whether the teachings of the prior art would, in and of themselves and without the benefits of appellant's disclosure, make the invention obvious.

*In Re Sponnoble*, 405 F.2d 578, 585, 160 USPQ 237, 243 (CCPA 1969) (emphasis in original).

Accordingly, the Examiner must consider only the teachings of the prior art references. If one of ordinary skill in the art would have modified the housing of Graham et al. to be plastic, he/she would not have known how to assemble the modified joint of Graham et al. Only by Applicant's disclosure would one of ordinary skill in the art be motivated to utilize a plastic housing with the joint of Graham et al.

Claim 11 has been amended to clarify that the radially outwardly angled flange (4.2) has an upper surface and a lower surface both being surrounded by plastic material of the joint housing (2). Graham et al., Pazdirek et al. and the other art of record do not disclose this and the other claimed limitations.

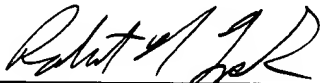
Claims 11 and 27, as well as claims 26 and 28 which depend from claims 11 and 27, respectively, are in condition for allowance. Since claim 11 has only been clarified and claim 27 has only removed new matter, no new issue has been presented and this Amendment should be entered.

In view of the foregoing, allowance of the above-identified patent application is respectfully requested.

Serial No. 09/554,025

Please charge any deficiency or credit any overpayment in  
the fees for this amendment to our Deposit Account  
No. 20-0090.

Respectfully submitted,

  
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